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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|--|-------------|----------------------|-----------------------------|------------------------|
| 10/633,620   | 08/05/2003  | Tokunori Kato        | 116786                      | 5371                   |
| 25944 7590 12/18/2007<br>OLIFF & BERRIDGE, PLC<br>P.O. BOX 320850<br>ALEXANDRIA, VA 22320-4850 |             |                      | EXAMINER<br>NGUYEN, QUYNH H |                        |
|  |             |                      | ART UNIT<br>2614            | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>12/18/2007     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

10/633,620

### Applicant(s)

KATO ET AL.

### Examiner

Quynh H. Nguyen

### Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to Amendment***

2. Applicant's amendment filed 10/1/07 has been entered. Claims 1-3 and 5-10 have been amended. Claim 4 has been canceled. No claims have been added. Claims 1-3 and 5-10 are still pending in this application, with claims 1, 3, 5, and 7-10 being independent.

***Claim Rejections - 35 USC § 101***

3. Claims 8-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 8-10, claim a computer-readable medium containing a terminal control computer program. However, Applicant's disclosure has no clear support of what medium has been positively disclosed as. Therefore, since the claimed terminal control programs to make a computer system execute a variety of processes for controlling a telephone terminal that performs a voice call are not tangibly embodied in a physical medium and encoded on a tangible computer-readable medium then the Applicants has not complied with 35 U.S.C 101. Hence, the 101 rejection is maintained.

***Claim Rejections - 35 USC § 103***

4. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimball (US Patent 5,953,322) in view of Zhang et al. (US Patent 5,953,407).

As to claims 1, 8, and 10, Kimball teaches the steps of:

A Network Control Unit (NCU) (Fig. 1, communications network 100) capable of inputting/outputting audio signals through the telephone line network (Fig. 1);

an audio input/output path provided besides the NCU and capable of inputting/outputting audio signals from/to an outside source through an outside source through an Internet network (col. 5, lines 21-30);

a switch device for switching an output destination of audio signals based on audio input from the transmitter/receiver and an input source of audio signals to be output as audio from the transmitter/receiver from the NCU to the audio input/output path according to user's operation (col. 3, line 60 through col. 4, line 4; col. 5, lines 10-20).

Kimball does not teach a telephone call notification device for notifying reception of an incoming call from the telephone line network when the incoming call from the telephone line network is received in the state in which the output destination and the input source of audio signals have been switched to the audio input/output path by the switch device.

Zhang et al. teaches a telephone call notification device for notifying reception of an incoming call from the telephone line network when the incoming call from the telephone line network is received (col. 4, lines 1-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Zhang into the teachings of Kimball for the purpose of alerting a telephone subscriber that a call is coming so that the subscriber would decide whether or not to answer the telephone call.

As to claims 2 and 6, Zhang et al. teaches the telephone notification device makes audio indicating that an incoming call has been received from the telephone line network (col. 4, lines 1-10 - *where Zhang discussed a call waiting tone alerting the user*).

Claim 3 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Kimball teaches an Internet terminal (Fig. 1, cellular telephone 10) with an Internet call function allowing input/output of audio signals transmitted through an Internet network; and a terminal device connected to the Internet terminal through an audio transmission path for transmitting audio signals, wherein the Internet terminal makes the terminal device output audio based on audio signals to perform a voice call (col. 3, line 12 through col. 4, line 37).

Claim 5 is rejected for the same reasons as discussed above with respect to claims 1 and 3. Furthermore, Kimball teaches and Internet terminal (Fig. 1, cellular telephone 10) and a telephone terminal (Fig. 1, telephones 80, 82).

Claims 7 and 9 are rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Kimball teaches and Internet terminal (Fig. 1, cellular telephone 10).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-3 and 5-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

qhn

*Quynh H. Nguyen*  
Quynh H. Nguyen  
December 12, 2007